UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,241	09/19/2003	Leo Jaw	CFP-2185 (15722/576)	6928

23595 7590 10/26/2005

NIKOLAI & MERSEREAU, P.A.
900 SECOND AVENUE SOUTH
SUITE 820
MINNEAPOLIS, MN 55402

EXAMINER	
PIERCE, JEREMY R	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/665,241	JAW, LEO	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4 and 7-22* is/are pending in the application.

4a) Of the above claim(s) *2,4,7-16,21 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on August 12, 2005 has been entered. Claims 3, 5, and 6 have been cancelled. Claims 1, 2, 4, 7-16, 19, and 20 have been amended. New claims 21 and 22 have been added. Claims 1, 2, 4, and 7-22 are currently pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 and 17-20, drawn to a woven band, classified in class 442, subclass 184.

II. Claims 2, 4, 7-16, 21, and 22, drawn to a method of making a compound yarn, classified in class 264, subclass 165.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of claim 1 may be made by weaving after the compound yarn has been split.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Amended claims 2, 4, 7-16, 21, and 22 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2, 4, 7-16, 21, and 22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 1 and 17-20 are considered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (U.S. Patent No. 4,991,234) in view of Kawabata et al. (JP 07-03638, Derwent English translation of the Abstract provided).

Greenberg discloses a flexible band made from woven material comprising nylon or other synthetic yarn and an elastic yarn (column 2, lines 63-67). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use

rubber yarn as the elastic yarn in Greenberg, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Greenberg does not disclose using split compound yarn. Kawabata et al. teach that splittable conjugate fiber can be used in either the weft or warp of woven fabric to provide increased fullness and excellent touch and drape (Abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use a splittable fiber in the band of Greenberg in order to provide a band with improved fullness and better touch, as taught by Kawabata et al. Kawabata et al. disclose splitting the yarns after weaving and the two components to be different from one another.

Claim 1 also recites a manner in which the compound yarn is formed, including extruding and cooling the filaments. However, the claims themselves are directed to a woven band. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

With regard to claim 17, Greenberg teaches using the band on the wrist (column 10, line 13). With regard to claim 18, recitation that the band is a headband is a recitation of an intended use and is not given patentable weight. Alternatively, it would have been obvious to a person having ordinary skill in the art at the time of the invention

to use the band as a headband in order to provide a support band for an injury to the head. With regard to claims 19 and 20, Kawabata et al. teach the conjugate fiber is formed from polyester and polyamide (Abstract).

Response to Arguments

8. Applicant's arguments filed August 12, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that the prior art lacks any suggestion that split compound yarn can be utilized to fabricate bands in a manner as the presented invention. However, Kawabata et al. teach that split compound yarns can be used in woven fabrics to provide excellence in touch and drape. Therefore, it would be obvious to use it in the woven fabric of Greenberg with the motivation being improving the touch of the fabric.

10. Applicant requests the Examiner to identify where the prior art would provide a suggestion to a person skilled in the art to attempt to modify Greenberg in a manner to reconstruct the present invention. However, the motivation to modify Greenberg is found in Kawabata et al. because Kawabata et al. specifically teach that the touch and drape of a fabric can be improved by incorporating compound split yarns into either the warp or weft of a woven fabric. The material of Greenberg is a woven fabric, so one of ordinary skill in the art of woven fabrics would have sufficient motivation to provide split compound yarns therein.

11. Applicant argues that the lack of application of other references to the claims reciting method limitations indicates that the Examiner recognizes patentability.

However, method claim limitations are only considered to the extent that they create a materially different product. The Examiner has not searched the method claims specifically for the steps recited. The method claims are directed to a separate patentable invention as set forth above in sections 2-4, and are therefore withdrawn from consideration.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy R. Pierce
October 19, 2005

ELIZABETH M. COLE
PRIMARY EXAMINER